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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/732,791 | 12/11/2000 | Yueh-O Yu | EM/YU/6285 | 2738 |

7590 09/27/2004

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| EXAMINER |
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LAZARO, DAVID R

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| ART UNIT | PAPER NUMBER |
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2155

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------------------|----------------------------------|--|
| Office Action Summary | Application No. 09/732,791 | Applicant(s) YU ET AL. | |
| | Examiner David Lazaro | Art Unit 2155 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33, 35, 37, 38, 40-50, 52-60, 63 and 66-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33, 35, 37, 38, 40-50, 52-60, 63 and 66-83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the amendment filed 06/30/04.
2. Claims 34, 36, 39, 51, 61, 62, 64 and 65 were canceled.
3. Claims 1-33, 35, 37, 38, 40-50, 52-60, 63 and 66-83 are pending in this Office Action.
4. The objections to the specification under 35 U.S.C. §112, first paragraph are withdrawn.
5. The objection to Claims 7, 36, 42, 52, 54, 55, 63, 64, 65 and 71 are withdrawn.
6. The rejections of Claims 1-5, 20, 39, 40, 42 under 35 U.S.C. §112, second paragraph, are withdrawn.

Claim Objections

7. Claim 1 is objected to because of the following informalities: In line 1, "the message" should be "a message". Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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9. Claims 1, 2, 5-12, 15, 16, 18, 19, 20-27, 30, 31, 33, 35, 37, 38, 40-47, 50-58, 63, 66-68 and 70 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,212,265 by Duphorne (Duphorne).

10. With respect to Claim 1, Duphorne teaches a method for actively providing users with the message concerning new mail, carried out by an electronic mail provider (Col. 2 lines 18-22 and Col. 3 line 60 - Col. 4 line 31), said method comprising: creating identification information for said new mail upon of said new mail by the electronic mail provider (Col. 2 lines 21-35 and Col. 3 line 60 - Col. 4 line 31); transforming said identification information into a transmission signal (Col. 2 lines 21-35); and transferring said transmission signal to a non-portable receiving terminal (Col. 2 lines 21-35).

11. With respect to Claim 2, Duphorne teaches all the limitations of Claim 1 and further teaches a step of automatically sending said identification information of said new mail to said non-portable receiving terminal after receiving a response from said non-portable receiving terminal (Col. 6 line 55 – Col. 7 line 11).

12. With respect to Claim 5, Duphorne teaches all the limitations of Claim 1 and further teaches a step of receiving said new mail by said users from said electronic mail provider through a telecommunication network after said users receiving said identification information (Col. 11 lines 2-4).

13. With respect to Claim 6, Duphorne teaches all the limitations of Claim 1 and further teaches said electronic mail provider transfers said transmission signal during a specific period (Col. 4 lines 40-47).

14. With respect to Claim 7, Duphorne teaches all the limitations of Claim 1 and further teaches said transmission signal further comprises advertisement information of said electronic mail provider (Col. 9 lines 31-67).

15. With respect to Claim 8, Duphorne teaches all the limitations of Claim 1 and further teaches said electronic mail provider transforms said identification information into said transmission signal and transfers said transmission signal by using an identification communication protocol for a caller terminal (Col. 6 lines 10-54).

16. With respect to Claim 9, Duphorne teaches all the limitations of Claim 1 and further teaches said identification information comprises a message subject for said new mail (Col. 4 lines 65-67).

17. With respect to Claim 10, Duphorne teaches all the limitations of Claim 1 and further teaches said identification information comprises a receiving date and a receiving time (Col. 4 lines 65-67).

18. With respect to Claim 11, Duphorne teaches all the limitations of Claim 1 and further teaches said identification information comprises an electronic mail address of a sender (Col. 8 lines 28-33).

19. With respect to Claim 12, Duphorne teaches all the limitations of Claim 1 and further teaches said identification information comprises a name of a sender (Col. 8 lines 28-33).

20. With respect to Claim 15, Duphorne teaches all the limitations of Claim 1 and further teaches said transmission signal is in a frequency shift key format (Col. 6 lines 48-50).

21. With respect to Claim 16, Duphorne teaches all the limitations of Claim 1 and further teaches said transmission signal is in a dual-tone multi-frequency format (Col. 6 lines 48-50).

22. With respect to Claim 18, Duphorne teaches all the limitations of Claim 1 and further teaches a filtering step prior to transferring said transmission signal, said filtering step is used for suspending said transmission signal corresponding with a plurality of set deletion conditions for said new mail (Col. 4 lines 44-47).

23. With respect to Claim 19, Duphorne teaches all the limitations of Claim 1 and further teaches further comprising a filtering step prior to transferring said transmission signal, said filtering step is used for transferring said transmission signal corresponding with a plurality of set permission conditions for said new mail (Col. 4 lines 44-47).

24. With respect to Claim 20, Duphorne teaches a method for obtaining a message a new electronic mail (Col. 2 lines 18-22), said method comprising: receiving a transmission signal actively transferred from an electronic mail provider through a non-portable receiving terminal (Col. 2 lines 21-35); and transforming said transmission signal into identification information (Col. 8 lines 8-41), said identification information being related to said new electronic mail that is not yet received or read by users (Col. 4 lines 10-31).

25. With respect to Claim 21, Duphorne teaches all the limitations of Claim 20 and further teaches automatically transferring a response from said receiving terminal to said electronic mail provider after receiving said transmission signal, and said step of automatically transferring used for requesting said electronic mail provider to

automatically transfer said identification information to said non-portable receiving terminal (Col. 6 line 55 – Col. 7 line 11).

26. With respect to Claim 22, Duphorne teaches all the limitations of Claim 20 and further teaches a step of displaying said identification information for notifying said users (Col. 8 lines 24-33).

27. With respect to Claim 23, Duphorne teaches all the limitations of Claim 20 and further teaches a step of receiving said electronic mail from said electronic mail provider through a telecommunication network after reading said identification information by said users (Col. 11 lines 2-4).

28. With respect to Claim 24, Duphorne teaches all the limitations of Claim 20 and further teaches said identification information comprises a message subject for said electronic mail (Col. 8 lines 28-33).

29. With respect to Claim 25, Duphorne teaches all the limitations of Claim 20 and further teaches said identification information comprises a receiving date and a receiving time (Col. 8 lines 28-33).

30. With respect to Claim 26, Duphorne teaches all the limitations of Claim 20 and further teaches said identification information comprises an electronic mail address of a sender. (Col. 8 lines 28-33).

31. With respect to Claim 27, Duphorne teaches all the limitations of Claim 20 and further teaches said identification information comprises a name of a sender (Col. 8 lines 28-33).

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32. With respect to Claim 30, Duphorne teaches all the limitations of Claim 20 and further teaches said transmission signal is in a frequency shift key format (Col. 6 lines 48-50).

33. With respect to Claim 31, Duphorne teaches all the limitations of Claim 20 and further teaches said transmission signal is in a dual-tone multi-frequency format (Col. 6 lines 48-50).

34. With respect to Claim 33, Duphorne teaches all the limitations of Claim 20 and further teaches said receiving terminal comprises an electronic mail identification phone (Col. 7 lines 11-26)

35. With respect to Claim 35, Duphorne teaches all the limitations of Claim 20 and further teaches said receiving terminal comprises a caller identification phone that has electronic mail identification function (Col. 7 lines 11-26 and Col. 8 lines 37-41).

36. With respect to Claim 37, Duphorne teaches all the limitations of Claim 20 and further teaches a filtering step prior to transferring said transmission signal, said filtering step suspending said transmission signal corresponding with a plurality of set deletion conditions for said new mail (Col. 4 lines 44-47).

37. With respect to Claim 38, Duphorne teaches all the limitations of Claim 20 and further teaches further comprising a filtering step prior to transferring said transmission signal, said filtering step transferring said transmission signal corresponding with a plurality of set permission conditions for said new mail (Col. 4 lines 44-47).

38. With respect to Claim 40, Duphorne teaches a system for actively transferring identification information of an electronic mail (Col. 2 lines 18-35), said system

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comprising: modulating means for transforming said identification information into a transmission signal (Col. 6 lines 44-56); and transferring means for transferring said transmission signal to a receiving terminal of a user (Col. 6 lines 44-56).

39. With respect to Claim 41, Duphorne teaches all the limitations of Claim 40 and further teaches a mail server which is set in said electronic mail provider, wherein said mail server is used for receiving and transferring said electronic mails (Col. 3 lines 60-66).

40. With respect to Claim 42, Duphorne teaches all the limitations of Claim 40 and further teaches said electronic mail provider transforms said identification information into said transmission signal and transfers said transmission signal by utilizing an communication protocol of identification service by a caller terminal (Col. 6 lines 44-56).

41. With respect to Claim 43, Duphorne teaches all the limitations of Claim 40 and further teaches said electronic mail provider transfers said transmission signal during a specific period (Col. 4 lines 40-47).

42. With respect to Claim 44, Duphorne teaches all the limitations of Claim 40 and further teaches said identification information comprises a message subject for said electronic mail (Col. 4 lines 65-67).

43. With respect to Claim 45, Duphorne teaches all the limitations of Claim 40 and further teaches said identification information comprises a date and a time (Col. 4 lines 65-67).

44. With respect to Claim 46, Duphorne teaches all the limitations of Claim 40 and further teaches said identification information comprises a sender's electronic mail address (Col. 8 lines 28-33).

45. With respect to Claim 47, Duphorne teaches all the limitations of Claim 40 and further teaches said identification information comprises a sender's name (Col. 8 lines 28-33).

46. With respect to Claim 50, Duphorne teaches all the limitations of Claim 40 and further teaches a filtering device for suspending said transmission signal corresponding with a plurality of set deletion conditions prior to transferring said transmission signal (Col. 4 lines 44-47).

47. With respect to Claim 51, Duphorne teaches all the limitations of Claim 40 and further teaches further teaches a filtering device for transferring said transmission signal corresponding with a plurality of set permission conditions prior to transferring said transmission signal (Col. 4 lines 44-47).

48. With respect to Claim 52, Duphorne teaches a system for assisting a user in acquiring a message concerning new electronic mail (Col. 2 lines 18-35), said system comprising: non-portable receiving means for receiving a transmission signal which is transferred from an electronic mail provider (Col. 7 lines 11-20); analyzing means for transforming said transmission signals into an identification information of said new electronic mail (Col. 8 lines 8-28); and displaying means for displaying said identification information (Col. 7 lines 48-57).

49. With respect to Claim 53, Duphorne teaches all the limitations of Claim 52 and further teaches a storage device for storing said identification information (Col. 8 lines 15-20).

50. With respect to Claim 54, Duphorne teaches all the limitations of Claim 52 and further teaches said electronic mail provider translates said identification information and transfers said transmission signal by utilizing an communication protocol of identification service by a caller terminal (Col. 6 lines 44-56).

51. With respect to Claim 55, Duphorne teaches all the limitations of Claim 52 and further teaches said identification information comprises a message subject for said new electronic mail (Col. 4 lines 65-67).

52. With respect to Claim 56, Duphorne teaches all the limitations of Claim 52 and further teaches said identification information comprises a date and a time (Col. 4 lines 65-67).

53. With respect to Claim 57, Duphorne teaches all the limitations of Claim 52 and further teaches said identification information comprises a sender's electronic mail address (Col. 8 lines 28-33).

54. With respect to Claim 58, Duphorne teaches all the limitations of Claim 52 and further teaches said identification information comprises a sender's name (Col. 8 lines 28-33).

55. With respect to Claim 63, Duphorne teaches all the limitations of Claim 52 and further teaches said non-portable receiving means comprises an identification phone of

a caller terminal which has electronic mail identification function (Col. 7 lines 11-26 and Col. 8 lines 37-41).

56. With respect to Claim 66, Duphorne teaches all the limitations of Claim 52 and further teaches said displaying means comprises an audio broadcasting device (Col. 7 lines 48-60).

57. With respect to Claim 67, Duphorne teaches all the limitations of Claim 52 and further teaches a filtering device for suspending said transmission signal corresponding with a plurality of set deletion conditions prior to transferring said transmission signal (Col. 4 lines 44-47).

58. With respect to Claim 68, Duphorne teaches all the limitations of Claim 52 and further teaches further teaches a filtering device for transferring said transmission signal corresponding with a plurality of set permission conditions prior to transferring said transmission signal (Col. 4 lines 44-47).

59. With respect to Claim 70, Duphorne teaches all the limitations of Claim 52 and further teaches further teaches a connecting device for connecting said receiving terminal and electronic mail provider when said transmission signal is received (Col. 7 lines 11-26).

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3, 4, 13, 14, 28, 29, 48, 49, 59, 60 and 71-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duphorne in view of U.S. Patent 5,933,478 by Ozaki et al. (Ozaki).

3. With respect to Claim 3, Duphorne teaches all the limitations of Claim 1 and but does not explicitly disclose suspending a connection between the mail provider and non-portable receiving terminal. Ozaki teaches that a connection between electronic mail provider and the receiving terminal is suspended by detecting a first deadline of establishing said connection (Col. 12 lines 40-56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that the method further comprises a step of suspending a connection between said electronic mail provider and said non-portable receiving terminal. One would be motivated to have this as it insures a user will receive notification of important newly received information (Col. 2 lines 4-28 of Ozaki).

4. With respect to Claim 4, Duphorne in view of Ozaki teaches all the limitations of Claim 3 and further teaches a step of re-establishing said connection and thereafter transferring said transmission signal (Col. 12 lines 40-56 of Ozaki).

5. With respect to Claim 13, Duphorne teaches all the limitations of Claim 1 but does not explicitly disclose identification information comprising a distinctive code. Ozaki teaches identification information comprising a distinctive code (Col. 9 lines 23-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as

indicated by Ozaki such that the identification information comprises a distinctive code. One would be motivated to have this as it helps give a user immediate access to newly received information (Col. 2 lines 15-19 and 40-44 of Ozaki).

6. With respect to Claim 14, Duphorne in view of Ozaki teaches all the limitations of Claim 13 and further teaches said distinctive code comprises a telephone number of said electronic mail provider (Col. 9 lines 23-30 of Ozaki).

7. With respect to Claim 28, Duphorne teaches all the limitations of Claim 20 but does not explicitly disclose identification information comprising a distinctive code. Ozaki teaches identification information comprising a distinctive code (Col. 9 lines 23-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that the identification information comprises a distinctive code. One would be motivated to have this as it helps give a user immediate access to newly received information (Col. 2 lines 15-19 and 40-44 of Ozaki).

8. With respect to Claim 29, Duphorne in view of Ozaki teaches all the limitations of Claim 28 and further teaches said distinctive code comprises a telephone number of said electronic mail provider (Col. 9 lines 23-30 of Ozaki).

9. With respect to Claim 48, Duphorne teaches all the limitations of Claim 40 but does not explicitly disclose identification information comprising a distinctive code. Ozaki teaches identification information comprising a distinctive code (Col. 9 lines 23-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the system disclosed by Duphorne and modify it as

indicated by Ozaki such that the identification information comprises a distinctive code. One would be motivated to have this as it helps give a user immediate access to newly received information (Col. 2 lines 15-19 and 40-44 of Ozaki).

10. With respect to Claim 49, Duphorne in view of Ozaki teaches all the limitations of Claim 48 and further teaches said distinctive code comprises a telephone number of said electronic mail provider (Col. 9 lines 23-30 of Ozaki).

11. With respect to Claim 59, Duphorne teaches all the limitations of Claim 52 but does not explicitly disclose identification information comprising a distinctive code. Ozaki teaches identification information comprising a distinctive code (Col. 9 lines 23-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the system disclosed by Duphorne and modify it as indicated by Ozaki such that the identification information comprises a distinctive code. One would be motivated to have this as it helps give a user immediate access to newly received information (Col. 2 lines 15-19 and 40-44 of Ozaki).

12. With respect to Claim 60, Duphorne in view of Ozaki teaches all the limitations of Claim 59 and further teaches said distinctive code comprises a telephone number of said electronic mail provider (Col. 9 lines 23-30 of Ozaki).

13. With respect to Claim 71, Duphorne teaches a method for transferring an identification information of an electronic mail (Col. 2 lines 18-35), said method comprising: transferring said identification information from an electronic mail provider to a receiving terminal which is predetermined by a corresponding user of said electronic mail (Col. 4 lines 20-31); transferring an identification information of said electronic mail

to said receiving terminal when a response message from said receiving terminal is received within a predetermined period (Col. 4 lines 20-31). Duphorne does not explicitly disclose suspending a connection if no response is received after a predetermined period. Ozaki teaches that a connection between electronic mail provider and the receiving terminal is suspended when no response is received after a predetermined period (Col. 12 lines 40-56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that the method further comprises suspending a connection between said electronic mail provider and said receiving terminal when no said response message is received within said predetermined period. One would be motivated to have this as it insures a user will receive notification of important newly received information (Col. 2 lines 4-28 of Ozaki).

14. With respect to Claim 72, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches reestablishing said connection between said electronic mail provider and said receiving terminal after suspending said connection and thereafter waiting a standby period (Col. 12 lines 40-56 of Duphorne).

15. With respect to Claim 73, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches a step of connecting to said electronic mail provider for getting said electronic mail after receiving said identification information (Col. 7 lines 27-29 of Duphorne).

16. With respect to Claim 74, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches a step of storing said identification information on said receiving terminal for displaying when said user queries (Col. 8 lines 8-28 of Duphorne).

17. With respect to Claim 75, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said electronic mail provider transfers said transmission signal during a specific period (Col. 4 lines 40-47 of Duphorne).

18. With respect to Claim 76, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said identification information comprises a message subject for said electronic mail (Col. 4 lines 65-67 of Duphorne).

19. With respect to Claim 77, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said identification information comprises a date and a time (Col. 4 lines 65-67 of Duphorne).

20. With respect to Claim 78, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said identification information comprises a sender's electronic mail address (Col. 8 lines 28-33 of Duphorne).

21. With respect to Claim 79, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said identification information comprises a sender's name (Col. 8 lines 28-33 of Duphorne).

22. With respect to Claim 80, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said identification information comprises a distinctive code (Col. 9 lines 23-30 of Ozaki).

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23. With respect to Claim 81, Duphorne in view of Ozaki teaches all the limitations of Claim 80 and further teaches said distinctive code comprises a telephone number of said electronic mail provider (Col. 9 lines 23-30 of Ozaki).

24. With respect to Claim 82, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches hardware of said receiving terminal has a caller identification function (Col. 8 line 38-41 of Duphorne).

25. With respect to Claim 83, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said receiving terminal further comprises a connecting device for establishing a connection between said receiving terminal and said electronic mail provider (Col. 7 lines 11-26).

26. Claims 17 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duphorne in view of U.S. Patent 5,875,234 by Clayton et al. (Clayton).

27. With respect to Claim 17, Duphorne teaches all the limitations of Claim 1. Although Duphorne teaches the transmission format is of an appropriate format for the email notification device according to Caller ID protocols (Col. 6 lines 44-47), Duphorne does not explicitly disclose the transmission signal is in a universal asynchronous receive and transmission (UART) format. Clayton teaches that the UART format is typically used for Caller ID services (Col. 9 lines 52-53). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that said transmission

signal is in a UART format. One would be motivated to have this as it can be easily integrated with existing protocols and infrastructure (Col. 2 lines 22-34 of Duphorne).

28. With respect to Claim 32, Duphorne teaches all the limitations of Claim 20.

Although Duphorne teaches the transmission format is of an appropriate format for the email notification device according to Caller ID protocols (Col. 6 lines 44-47), Duphorne does not explicitly disclose the transmission signal is in a universal asynchronous receive and transmission (UART) format. Clayton teaches that the UART format is typically used for Caller ID services (Col. 9 lines 52-53). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that said transmission signal is in a UART format. One would be motivated to have this as it can be easily integrated with existing protocols and infrastructure (Col. 2 lines 22-34 of Duphorne).

29. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Duphorne in view of U.S. Patent Application Publication 2001/0012286 by Huna et al. (Huna).

30. With respect to Claim 69, Duphorne teaches all the limitations of Claim 20 but does not explicitly disclose a switch device for controlling operation of the non-portable receiving means. Huna teaches a switch device for controlling the receiving means such that transmission signals concerning new email are received when it is on and not received when it is off (Page 6 [0071]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the system disclosed by

Duphorne and modify it as indicated by Huna such that there is a switch device for controlling operation of said non-portable receiving means, said non-portable receiving means receiving said transmission signal when said switch device is on, and said receiving terminal stopping receiving said transmission signal when said switch device is off. One would be motivated to have this as it allows the user to configure the notification system according to their current preference (Page 6 [0071]).

Response to Arguments

31. Applicant's arguments filed 06/30/04 have been fully considered but they are not persuasive.

32. Applicants argue from page 29 of Remarks - "*Thus, while Duphorne teaches notification of new mail, the notification is not in the form of a transmission signal transformed by the electronic mail provider to include identification information created by the provider.*"

a. The notification of new mail taught by Duphorne, as stated in Col. 2 lines 18-22, can, in some embodiments, include the form of a transmission signal transformed by the electronic mail provider to include identification information created by the provider. Duphorne states in Col. 3 line 60 - Col. 4 line 2, "it is noted that in some embodiments the local telco provides user 18's email service". As such, the notifications for any new email would be transformed and provided by the '*electronic mail provider*' which in this case is the local telco.

33. Applicants argue from page 30 of Remarks - *"None of these signals corresponds to the claimed transformed identification information."*

b. The Applicants do not explain how these signals differ from the claimed transformed identification information.

Duphorne teaches a notification of a new email as stated in Col. 2 lines 21-35.

The notification can include information specifically identifying the email as noted in Col. 6 lines 1-3 of Duphorne. According to the MPEP 2106[R-2].II.C., *"Office personnel are to give claims their broadest reasonable interpretation"*. As such, a notification of a new email can be considered within the scope of "identification information". This notification is further transformed into a transmission signal and transmitted to the user (Col. 2 lines 21-35). Therefore, Duphorne is sufficiently within the scope of the claimed transformed identification information.

34. Applicants argue from page 30 of Remarks - *"Because the ISP email server of Duphorne are passive, the method and system of Duphorne are different from that of the claimed invention. The ISP email server 16a must receive a query signal from a query software maintained by a central office 14 first or an information service provider so as to transmit a preliminary email notification signal in respond to the query signal while the identification information and the transmission signal of new email of the claimed invention are created, transformed and then is transmitted to a receiving terminal by a email provider or a ISP email server. Moreover, the steps of transmitting a query signal to the remote email server and transmitting, in response to the query signal, a preliminary email notification signal from the remote email server to a central office coupled to a public switched telephone network of Duphorne cannot be omitted since this modification would result in an incomplete subject matter which Duphorne*

particularly pointed out and directed to. Duphorne actually discloses a different method and system from the claimed invention, which notifies users of the arrival of their email without the need of maintaining an online connection. "

c. The focus of the Applicants' argument concerns the querying of the remote email server. However, Duphorne teaches, in some embodiments, the email server "automatically transmits the preliminary email notification signal" when new email arrives at the server for a user (Col. 4 lines 10-15). This includes the embodiment where the local telco provides the email service (Col. 4 lines 15-20). As such, a "query signal" is not required as Applicants argue, and Duphorne teaches the identification information and the transmission signal of new email is created, transformed and transmitted to a receiving terminal by the email provider (the local telco). Obviously, some steps can be omitted in some embodiments such as the "automatic" embodiment discussed above, where the step of "querying" for new email is omitted. Furthermore, the Applicants do not specifically cite evidence from Duphorne (columns and lines) to support their arguments. Applicants also do not explain the significance of "*without the need of maintaining an online connection*" in terms of its relation to any specific claim language.

35. Applicants argue from page 31 of Remarks - "*...while the claimed invention allows the users to receive transmission signals actively transferred from an email provider.*"

d. As explained in the previous argument, Duphorne teaches, in some embodiments, the email server "automatically transmits the preliminary email notification signal" when new email arrives at the server for a user (Col. 4 lines 10-15). This includes the embodiment where the local telco provides the email service (Col. 4 lines 15-20). As such, Duphorne also allows the users to receive transmission signals actively transferred from an email provider (the local telco).

36. Applicants argue from page 31 of Remarks - "...*there is no need of a modulating means for transforming an identification information to a transmission signal.*"

e. Duphorne specifically states that the email notification signal transmitted to the user is a "frequency shift keyed" signal or a "dual tone multi-frequency" signal. Both of these are forms of modulated signals and would therefore require "modulating means".

37. Applicants argue from page 32 of Remarks - "...*while the receiving means of the claimed invention receives a transmission signal which is transferred from an electronic mail provider.*"

f. The notification of new mail taught by Duphorne, as stated in Col. 2 lines 18-22, can, in some embodiments, include the form of a transmission signal transformed by the electronic mail provider to include identification information. This transmission signal is to be received at the email notification device. Duphorne further states in Col. 3 line 60 - Col. 4 line 2, "it is noted that in some

embodiments the local telco provides user 18's email service". Therefore, Duphorne teaches the receiving means (email notification device) receives a transmission signal which is transferred from an electronic mail provider (local telco).

38. Applicants argue from page 32 of Remarks - *"...the combination of Ozaki would not have suggested modification of the method or system of Duphorne since the system of Duphorne must query the user's ISP email server to determine whether any email addressed to the user is received by and/or stored thereon."*

g. As explained earlier, the system of Duphorne is not required to query the email server. In some embodiments, the email server "automatically transmits the preliminary email notification signal" when new email arrives at the server for a user (Col. 4 lines 10-15). This includes the embodiment where the local telco provides the email service (Col. 4 lines 15-20).

39. Applicants argue from page 33 of Remarks - *"Therefore, a step of suspending a connection between the electronic mail provider and the receiving terminal when no the response message is received within the predetermined period would not be necessary for the teaching of Duphorne since a step of transmitting a query signal to the remote email server and a step of transmitting, in response to the query signal, a preliminary email notification signal from the remote email server to a central office coupled to a public switched telephone network are previously performed."*

h. As explained earlier, Duphorne states in Col. 3 line 60 - Col. 4 line 2, "it is noted that in some embodiments the local telco provides user 18's email service". Therefore, the electronic mail provider would be transferring the identification information to the receiving terminal, and the combination of Duphorne and Ozaki is proper.

40. Applicants argue from page 33 of Remarks - "*...the respective teaching of Clayton and Huna do not disclose the elements of the claimed invention which the teaching of Duphorne does not mention.*"

i. Applicants do provide any supportive evidence or explanation as to exactly what elements are not disclosed and why the interpretation presented by the examiner in the Office Action rejection is not sufficient to be within the scope of the claim limitations. The Examiner asserts the rejections as being proper.

Conclusion

41. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lazaro whose telephone number is 703-305-4868 (571-272-3986 after October 27). The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Lazaro
September 21, 2004


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SUPERVISORY PATENT EXAMINER